

REMARKS

New claims 36-39 are added for consideration. It is respectfully submitted that the present amendments present no new matter and place this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I: Interview Summary

Applicants would like to thank the Examiner for the telephone interview conducted on February 7, 2008 between Applicants' attorney Michael Krenicky and Examiner Metzmaier. Applicants' attorney discussed the new matter rejection and the term "substantially". Applicants urged that it was not new matter and asked the Examiner to reconsider. The Examiner urged Applicant to site case law relating to the addition of new matter. No agreement was reached with the Examiner on the new matter issue over the phone other than Applicant agreeing to make a written response. No claim other than claim 1 was discussed during the interview. No prior art was discussed.

II. The Rejection of Claims 1-20 and 27-35 under 35 U.S.C. 112 and New Matter

Claims 1-20 and 27-35 stand rejected as failing to comply with the written description requirement and adding new matter with respect to --substantially unagglomerated particulate starting material. Applicants traverse this rejection.

It is well established that the claimed subject matter need not be described "*in haec verba*" in the original specification in order to satisfy the written description requirement. *In re Wright*, 866 F.2d at 425. Rather, "the test . . . is whether a person of ordinary skill in the art would recognize that the applicant possessed what is claimed in the later filed application as of the filing date of the earlier filed application." *Noelle v. Lederman*, 355 F.3d 1343, 1348 (Fed. Cir. 2004). The same standards govern whether new matter has been added to the specification. See *TurboCare*, 264 F.3d at 1118. For a more recent explanation of the law, see also *In Re Paul Lew and Jason Schiers* (CAFC 2007).¹

¹ Applicants note that in the *In re Paul Lew and Jason Schiers* case, the CAFC found substituting "curved member" for a "ball bearing" was an impermissible broadening.

Applicants clearly possessed substantially un-agglomerated particulate starting material at the time this application was filed. For example, Applicants direct the Examiner's attention to the following:

- One page 3, Applicants explain that to obtain the desired result it is important to adjust the high shear rate to the particle size of the particulate material provided and to the amount of liquid added to the process, **to avoid agglomeration of the particles**. In other words **keeping agglomeration low or even completely avoiding it** is important in the process of the invention and the amount of agglomeration can be controlled by adjusting the shear rate and/or the amount of liquid added to the process to match the size of the particles being treated.
- Particulate starting material is specifically defined in the Application on page 5 and refers to the particles chosen to be exposed to the method of the present invention.
- The term "Substantially avoiding agglomeration of particles" as used herein means that no major portions of particles of a particulate composition agglomerates. The person skilled in the art knows that for most particulate materials minor portions of individual particles may adhere to or agglomerate to each other, while, however, this particulate material may not be characterized as agglomerated. The skilled person would readily comprehend the meaning of the term . . . as meaning that although in principle all particles is kept as single unagglomerated particles, insignificant levels of agglomeration of particles may still occur, without affecting the overall properties of the composition. In particular "Substantially avoiding agglomeration of particles" means that more than 80%, in particular more than 85% . . . of the un-agglomerated particles in the particulate starting material **is kept in the unagglomerated form**.
- The Applicants discusses many suitable particles for use in accordance with the present disclosure. See pages 8-10.
- The examples utilize sodium sulphate particles, raw salt particles, and nonpareils. For example, see page 20.

The Examiner's assertion that the terms --substantially un-agglomerated particulate starting material-- is new matter is incorrect. A person of ordinary skill in the

art would recognize that Applicants possessed what is claimed in the amendment as of the filing date of the application. The original disclosure clearly explains that the invention relates to avoiding agglomeration of the particles, and explains that keeping agglomeration low or even completely avoiding it is *important* in the process of the invention. See page 3.

Further, the Examiner's assertion that the term "Substantially avoiding agglomeration of particles" cannot be equated with "substantially un-agglomerated particulate starting material" is incorrect. Based on the specification as a whole, and specifically the definitions noted above, one of ordinary skill in the art would have recognized that applicants possessed "substantially un-agglomerated particulate starting material" at the time the application was filed. As noted above the definition of "Substantially avoiding agglomeration of particles" specifically includes a meaning that -- that more than 80%, in particular more than 85% . . . of the un-agglomerated particles in the particulate starting material **is kept in the unagglomerated form**.-- Since it is clearly explained that the starting particles are **kept in the unagglomerated form**, then the particles were clearly substantially unagglomerated to start with.

Moreover, the Examiner's assertion that substantially unagglomerated starting material would necessarily include those particles having greater than 50% unagglomerated particles is incorrect. Applicants' disclosure does not say that about half of the starting material can be agglomerated. Applicants believe that if one of ordinary skill in the art were to utilize percentages and numbers to quantify "substantially", which applicants do not believe would be necessary, one of skill in the art would look at the numbers in found in the definition of "Substantially avoiding agglomeration of particles". These numbers are significantly higher and produce a much more uniform starting material than the "greater than 50%" offered by the Examiner. Accordingly, Applicants believe that the Examiner failed to consider the specification when making this determination. In fact, the Examiner has offered no evidence of where he obtained his proposed definition for the alleged "plain meaning" which includes up to about 50%.

Applicants further note the term "substantially" is ubiquitous in patent claims, and is definite and clear. The U.S. Supreme Court and the Court of Customs and Patent Appeals have held that the use of the term "substantially" does not render claims indefinite if one skilled in the art can determine the scope of the claimed invention. The Federal Circuit has affirmed those decisions. In *Andrew Corp. v. Gabriel Electronics*, 6

USPQ2d 2010, 2012 (Fed. Cir. 1988), the court held that the use of, *inter alia*, "substantially equal" did not render the claims indefinite.

The criticized words are ubiquitous in patent claims. Such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts.

Moreover, section 2173.05(b) of the Manual of Patent Examining Procedure instructs examiners to permit claims with terms, such as "substantially," that are reasonably distinct and precise.

In the present case, persons skilled in the art have investigated the effect of subjecting starting materials, kept in the un-agglomerated form, to a high shear rate and have discovered that that the process improves the average strength of the particles. The original disclosure clearly teaches that it is necessary to avoid agglomeration of the particulate material. Hence, the skilled worker would understand that, in accordance with the present disclosure it would have been important to select substantially un-agglomerated particulate starting material. Applicants were in possession of this at the time the application was filed. Accordingly, applicants urge that the Examiner reconsider the new matter rejection.

III: The Rejection of Claims 1-20 and 27-35 as Anticipated/Obvious.

Claims 1-20 and 27-35 stand rejected under 35 U.S.C. 102(b) as being anticipated by or obvious under 35 U.S.C. 103(a) by Guraya (U.S. Patent No. 6,737,099 herein after referred to simply as "Guraya I"). However, Guraya I does not disclose or suggest the substantially un-agglomerated particulate starting material recited in the claims previously added by amendment. Applicants urge the Examiner to reconsider the earlier arguments since substantially un-agglomerated particulate starting material is not new matter. Specifically, the Examiner is urged to reconsider the arguments filed on 22 May 2007.

Claim 1 as amended, requires, *inter alia*, substantially un-agglomerated particulate starting material. Further, Claim 1 requires that more than 80% of the un-agglomerated particles in the substantially un-agglomerated particulate starting material *remain* un-agglomerated. In other words, the starting material of the present disclosure is kept in the unagglomerated form throughout the process. Nowhere does Guraya

describe such a process. Guraya I describes agglomerated starting materials that must be deagglomerated. See for example, Col. 3, lines 27-37 which describes obtaining deagglomerated materials from agglomerated materials. Accordingly, the materials of Guraya are agglomerated by its process. Accordingly, Guraya I does not anticipate independent claim 1, or claims which depends upon claim 1.

Further, to anticipate, the identical subject matter must not only be previously known, but the knowledge must be sufficiently enabling to place the information in the possession of the public. Guraya I is deficient as a reference as it fails to keep the starting material unagglomerated throughout the process and does not show that more than 80% of the un-agglomerated particles in the substantially un-agglomerated particulate starting material remain un-agglomerated. Accordingly, the public was not in possession of the claimed invention, or the knowledge that applying a substantially un-agglomerated particulate starting material to high shear improves the average strength of particles. Accordingly, Guraya I does not anticipate claim 1 as amended herein. Reconsideration is urged.

In order to be obvious, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As described above, Guraya I fails to describe a substantially un-agglomerated particulate starting material. Accordingly, Guraya I does not make amended claim 1, and the claims which depend therefrom obvious. Reconsideration is urged.

Further, as Guraya I relates to starting materials in need of deagglomeration, the reference does not provide a reason to provide one of skill in the art to subject with a reason to substitute agglomerated starting materials such as those of Guraya I with substantially unagglomerated starting materials of the claimed invention. Accordingly, Claim 1, and all claims which depend therefrom are not obvious.

Claims 1-20 and 27-30 stand rejected under 35 U.S.C. 102(a) as being anticipated by or obvious under 35 U.S.C. 103(a) by Guraya. (WO 02/078457 herein after referred to simply as "Guraya II"). However, Guraya II does not disclose or suggest the substantially unagglomerated particulate starting material recited in the claims as amended herein.

As the Examiner's basis for this objection is otherwise the same as the rejection for Guraya I, the Applicants incorporate herein by reference in its entirety the response above relating to Guraya I. Applicants' disclosure is not anticipated or made obvious by Guraya II for the same reasons stated above with respect to Guraya I, and reconsideration is urged.

Claims 1-4, 10, 13-16, 19-20 and 27-30 stand rejected as obvious under 35 U.S.C. 103(a) by Kodokian (US Patent No. 5,928,577 herein after referred to simply as "Kodokian"). However, Kodokian does not disclose or suggest the substantially un-agglomerated particulate starting material recited in claim 1 as amended herein.

Kodokian relates to spherical particles of a copolymer composition including a crosslinker and/or coating additive(s) the particles being useful for coating various substrates; and a process for making such particles including forming the copolymer and unreacted crosslinker and/or other additives in a coating matrix.

Nowhere does Kodokian describe applying a substantially un-agglomerated particulate starting material to high shear in order to obtain *improved average strength* of particles. Further, Claim 1 requires that more than 80% of the un-agglomerated particles in the substantially un-agglomerated particulate starting material *remain* un-agglomerated. Nowhere does Kodokian describe a process where un-agglomeration is maintained throughout the process. Accordingly, Kodokian does not make the claimed invention obvious.

IV: New Claims

Applicants request that the Examiner consider new claims 36-39. It is believed that no new matter is presented. Should any additional fees be due the Examiner is authorized to charge Applicants Deposit Account No. 50-1701.

V. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

Date: February 8, 2008

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